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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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CANTELMO, GREGG

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/773,036

Applicant(s)

PROBST ET AL.

Examiner

Gregg Cantelmo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003 and 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 17, 2003 has been entered.

### ***Response to Amendment***

2. In response to the amendments received October 7, 2003:
- a. Claims 1-8 and 10-12 are pending
  - b. The prior art rejection of Loewen stands.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1-8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent No. 4,712,299 (Loewen).

Loewen discloses a common carrier comprising: an elongate support member 30 having a plurality of locating holes 12 disposed thereon, a plurality of current collector screens 8 integrally formed with and extending from a portion of support member 30 (Fig. 1). More clearly with respect to the current collector screen limitation. The term current collector is broadly interpreted as any collector material that can collect a current. Metal materials would be a broad example since metals are known to amass and conduct current. Thus Loewen, teaching that the sheet is a metal is a broad teaching of a current collector. Further the structure of the collectors is disclosed as a screen, but the particulars of the screen is not further defined. Thus a substrate having openings therethrough defines a particular screen pattern. The material of the sheet is a metal (abstract) thus members 8 are current collectors. Members 8 further have openings formed therethrough and thus are considered to be screens of the patterns shown in Fig. 1. In addition while the entire surface of members 8 are not planar, each of the members 8 comprise planar first and second surfaces. For example the lower portions of the members 8 have planar first and second surfaces wherein the peripheral edges of these portions are not connected to an immediately adjacent member. Members 8 comprises planar first and second faces which are entirely planar during the initial manufacturing steps as shown in Fig. 1 (as applied to claim 1).

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The current collector screens 8 are connected to the support member 30 through respective external tabs 14 extending from the current collector screen (Fig. 1 as applied to claim 2).

The current collector screens 8 are spaced apart equidistant from one another and are all oriented in the same position relative to the support member 30 (Fig. 1 as applied to claim 3).

The contacts receive a coating with a highly conductive metal (col. 2, ll. 40-42 as applied to claim 4).

Loewen discloses a common carrier comprising: an elongate planar support member 30 having at least one datum (holes 12), a plurality of current collector screens 8 integrally formed with and extending from a portion of support member 30 (Fig. 1). More clearly with respect to the current collector screen limitation. The term current collector is broadly interpreted as any collector material that can collect a current. Metal materials would be a broad example since metals are known to amass and conduct current. Thus Loewen, teaching that the sheet is a metal is a broad teaching of a current collector. Further the structure of the collectors is disclosed as a screen, but the particulars of the screen is not further defined. Thus a substrate having openings therethrough defines a particular screen pattern. The material of the sheet is a metal (abstract) thus members 8 are current collectors. Members 8 further have openings formed therethrough and thus are considered to be screens of the patterns shown in Fig. 1. In addition while the entire surface of members 8 are not planar, each of the members 8 comprise planar first and second surfaces. For example the lower portions

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of the members 8 have planar first and second surfaces wherein the peripheral edges of these portions are not connected to an immediately adjacent member. Members 8 comprises planar first and second faces which are entirely planar during the initial manufacturing steps as shown in Fig. 1 (as applied to claim 5).

With respect to the article of claim 5 capable of being oriented with respect to a tool through the datum:

As discussed above, Loewen teaches of plural holes 12 (datum) to guide the strip of metal through a tool (col. 4, ll. 23-26). Applicant is further reminded that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the

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prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). As applied to claim 5.

The current collector screens 8 are connected to the support member 30 through respective external tabs 14 (Fig. 1 as applied to claim 6).

The external tab 14 connects at a substantially perpendicular orientation with the support member 30 (Fig. 1 as applied to claim 7).

The contacts receive a coating with a highly conductive metal (col. 2, ll. 40-42 as applied to claim 8).

Loewen discloses a common carrier comprising: an elongate planar support member 30 having at least one datum (holes 12), a plurality of current collector screens 8 integrally formed with and extending from a portion of support member 30 by respective tabs 28 (Fig. 1). More clearly with respect to the current collector screen limitation. The term current collector is broadly interpreted as any collector material that can collect a current. Metal materials would be a broad example since metals are known to amass and conduct current. Thus Loewen, teaching that the sheet is a metal is a broad teaching of a current collector. Further the structure of the collectors is disclosed as a screen, but the particulars of the screen is not further defined. Thus a substrate having openings therethrough defines a particular screen pattern. The material of the sheet is a metal (abstract) thus members 8 are current collectors. Members 8 further have openings formed therethrough and thus are considered to be screens of the patterns shown in Fig. 1. In addition while the entire surface of members 8 are not planar, each of the members 8 comprise planar first and second surfaces. For

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example the lower portions of the members 8 have planar first and second surfaces wherein the peripheral edges of these portions are not connected to an immediately adjacent member. The contact receives a coating (secondary material). Members 8 comprises planar first and second faces which are entirely planar during the initial manufacturing steps as shown in Fig. 1 (col. 2, ll. 40-45; as applied to claim 11).

### ***Response to Arguments***

4. Applicant's arguments filed October 7, 2003 have been fully considered but they are not persuasive.

The amendment to claims 1, 5 and 11 does not differentiate itself from the product disclosed in Loewen.

Loewen teaches of members which comprise planar portions wherein the planar portions of the members are not connected to the peripheral edges of adjacent members.

At one point during processing the entire extent of the members are planar (see Fig. 1 and in particular the left hand portion of the member). As can be seen in Fig. 1 the initial processing of the members maintains a planar configuration across the entire extent of the members.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loewen in view of U.S. patent No. 3,803,537 (Cobaugh).

The teachings of claims 1, 4 and 11 have been discussed above and are incorporated herein.

The difference between claims 10 and 12 and Loewen is that Loewen does not disclose of the secondary material to be carbon or gold.

Loewen teaches that it is desirable to coat the contact materials with a highly electrical conductive coating.

One skilled in the art of electrical contacts would have recognized that gold is a highly conductive material and one which is well known to have been used in the art of forming electrical contact members (see Cobaugh col. 5, ll. 1-2).

The motivation for plating the member of Loewen with gold is that it would have provided a coating having excellent electrical conductivity.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Loewen by coating the member with gold since it would have provided a coating having excellent electrical conductivity.

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***Response to Arguments***

7. Applicant's arguments filed October 7, 2003 have been fully considered but they are not persuasive.


Applicant provides no further arguments apart from those directed to the 102(b) rejection of Loewen. See item 4 above, incorporated herein.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (703) 305-0635. The examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (703) 308-2383. FAX communications should be sent to the appropriate FAX number: (703) 872-9311 for After Final Responses only; (703) 872-9310 for all other responses. FAXES received after 4 p.m. will not be processed until the following business day. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gregg Cantelmo  
Patent Examiner  
Art Unit 1745

gc



October 19, 2003